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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595
8933	7590	01/09/2008		
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			EXAMINER BASHORE, WILLIAM L	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,9,10,12,17,18,20 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,9,10,12,17,18,20,26 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 10/17/2007, to the original application filed **12/18/1998**.
2. Claims 1-2, 4, 9-10, 12, 17-18, 20, 26-34 pending. Claims 5-6, 8, 13-14, 16, 21-22, 35-36 have been canceled. Claims 1, 9, 17, 26-30 are independent claims.

Allowable Subject Matter

3. **Claims 27-30** are allowed.

Claim Rejections - 35 USC § 103

4. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-2, 4, 9-10, 12, 17-18, 20, 26, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Redax (hereinafter Redax), Web article by Digital Applications, Inc., downloaded on 3/10/2005, with a last update of 12/13/1997, downloaded from <<http://web.archive.org/web/19971221013620/http://digapp.com/>>, pages 1-2.**

In regard to independent claim 1, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble "*A method of redacting content from a document in electronic form, comprising the steps of*").

Anderson does not specifically teach a PDF data stream. However, Redax teaches redaction as applied to a PDF file (Redax paragraph 1). It is noted that electronic PDF files generally comprise an underlying set of instructions that includes information on said PDF document content (i.e. location data of text and images, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax's PDF file containing said instructions to Anderson's document data stream, providing Anderson the benefit of redacting PDF documents, increasing the versatility of Anderson as applied to a wider variety of document types.

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 1 "*selecting a geometric area on the document for redaction, said geometric area having content comprising at least one image*", and "*representing said geometric area as one or more annotation objects*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image/text objects, annotation/redaction area objects, etc.) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 "*identifying information in the document representing content and location and nature of content*", and "*representing said identified information as one or more content objects, said one or more content objects comprising one or more image and text occurrence objects;*").

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose “*an output file PDF file comprising said PDF stream except for portions of said PDF data stream corresponding to said identified content*” with said (image based) content not present, hence allowing a redacted document to be producible from said output file. However, as explained above, PDF files generally contain an underlying set of instructions (i.e. content, layout instructions, etc.). Redax page 1 paragraph 3, teaches opening a (PDF) document in Acrobat Exchange. The document is searched and words are tagged and overlaid with exemption codes. Since Redax teaches that a new (PDF) document is created and saved (reflective of user editing and redacted deleted text), said new edited document reflects a new set of saved instructions (exemption codes in place of the deleted data) accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax’s redaction method to Anderson’s data stream and redaction of text and images, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent PDF form for ultimate security (preventing document reverse-engineering, etc.).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 “*identifying content....to produce a redacted document.*”).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47).

In regard to dependent claim 2, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 2).

In regard to dependent claim 4, Anderson/Pontin/Redax teaches a final-form document with annotated and/or redacted images/text are present in said document, said annotations permanently replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

In regard to claims 9-10, claims 9-10 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-2, respectively and are rejected along the same rationale.

In regard to claim 12, claim 12 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 4, and is rejected along the same rationale.

In regard to claims 17-18, 20, claims 17-18, 20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1, 2, 4, and are rejected along the same rationale.

In regard to independent claim 26, claim 26 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 31-34, Anderson does not specifically disclose replacement via “pixel by pixel”. However, Anderson teaches images, and Redax teaches PDF (image based). Since modification of images in an electronic document generally involve modification of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to

implement redaction via pixel by pixel replacement and/or modification applied to a final output file (i.e. a PDF file), providing the benefit of image based redaction.

Response to Second Affidavit under 37 CFR 1.132

6. Applicant's second Affidavit under 37 CFR 1.132 filed 10/17/2007 is insufficient to overcome the rejection of the pending claims under 35 USC 103(a) as being unpatentable over Anderson in view of Redax.

Applicant's second affidavit expands upon various points raised in the previous affidavit filed 1/24/2007. The exhibits shown are the same as presented in said first affidavit.

The examiner respectfully maintains that Applicant has failed to establish a clear nexus between the evidence of secondary considerations, and the merits of the claimed invention, for at least the following reasons:

Applicant declares on page 2 of the affidavit that Redax 1.0 was not capable of redacting images, and that said product did not meet with commercial success. Applicant asserts that commercial success of its subsequent release of Redax 1.5 was due to its new capability of redacting images along with text. Applicant goes on to assert that considerable time was spent promoting Redax 1.0, citing many conferences, trade shows, etc., and that less time was spent promoting Redax 1.5 and above (which includes image redaction).

At the outset, the amount of promotion given to a product does not necessarily equate to commercial success, since many well known reasons exist for promoting a product (i.e. maintaining visibility, budget constraints/surplus, etc.). As stated in the previous response, Applicant's conclusion appears to be an opinion, since there exists many possible reasons for commercial success outside of

what Applicant states (i.e. increased and/or more strategic advertising, inclusion as part of promotions, additional added features and compatibilities, more robust less buggy version, etc.). Applicant's "belief" of commercial success is an opinion, not a presentation of facts.

Paragraph 8 presents Redax Lite as commercially unsuccessful, it is unclear as to whether this was due exclusively to its text-only redaction capability. It is also unclear whether the users who upgraded to later versions of Redax did so exclusively for image redaction capability. Applicant's "understanding" that low sales of the former can be attributed to a lack of image redaction capability is merely an opinion.

Paragraph 9 purports that there were no significant bugs or errors in Redax 1.0 or Redax Light that hindered the commercial success of these two products. Applicant goes on to state that there were no significant new or enhanced features in Redax version 1.5 or later (other than to offer the ability to redact both text and images) that contributed to its success. It is unclear what Applicant defines as "significant", since it is possible that one or more minor (i.e. insignificant) bugs, errors, and added features that can possibly make a difference to some users.

Applicant asserts that Redax 1.5 and newer has gained great acceptance from government customers, and widely praised in the industry. Although a list of government customers is provided, it is unclear whether this translates into actual use of the product. Applicant goes on to say (at paragraph 11) that every government agency, corporation, and law firm that purchased redax 1.5 and later versions is using the software. This is at best an opinion, since the alleged support calls, upgrade requests, replacement serial number requests, etc. are not quantified.

As stated in the previous response, Applicant presents exhibits A-K in support of professional approval in the industry. However, said exhibits merely reflect the opinions of their respective authors, not actual evidence of success through presentation of facts.

It is respectfully noted that even if the instant declaration is accepted (the Office does not admit this), it is the examiner's opinion that commercial success does not obviate the current rejection under 35 USC 103(a), especially in view of the recent KSR court ruling. As much as the examiner can ascertain, Applicant alleges that the novel feature of its product lies in its image redaction capability. This claimed feature has been rendered obvious to the skilled artisan, as presented in the instant rejections.

In view of the strength of the cited art of record applied to the instant rejections, and Applicant's failure to establish a clear nexus between the evidence and the merits of the claimed invention, the examiner has determined that Applicant's declaration does not overcome the obviousness rejections of the pending claims.

Response to Arguments

7. Applicant's arguments filed 10/17/2007 have been fully and carefully considered but they are not persuasive.

The examiner appreciates Applicant's noting of the erroneous Pontin reference in the header of the rejection. This unintentional oversight has been corrected. Since the Pontin reference was not used in the body of the rejections, it is the examiner's opinion that no new grounds of rejection have been introduced.

Applicants arguments on page 12 of the amendment are directed to expanded explanations provided in the instant declaration, which the examiner has accordingly addressed above.

Applicant argues on page 13 of the amendment that the cited art of record (Anderson and Redax) does not teach Applicant's claimed invention. Applicant argues each reference separately. While the examiner admits that Anderson does not teach pdf files, Anderson does redact text and images from documents. Redax clearly teaches redacting text from pdf files (a form of document). Accordingly,

Redax's pdf redaction technique is applied to Anderson, providing Anderson the capability of redacting text and images from pdf documents.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 9:00 am - 5:30 pm EST.

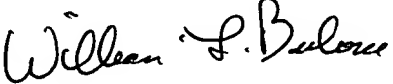
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Bashore/
Primary Examiner
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WILLIAM BASHORE
PRIMARY EXAMINER